

REMARKS

The present application was filed with claims 1-12 on February 14, 2001, as a divisional of U.S. Patent Application Serial No. 09/004,046, filed January 7, 1998, which claims priority to U.S. Provisional Application Serial No. 60/037,962 filed February 20, 1997. Claims 11 and 12 were canceled in a first Preliminary Amendment filed concurrently with the present application. Claims 13-25 were added in a second Preliminary Amendment filed May 18, 2001. Claims 1-10 and 13-25 are currently pending in the application, with claims 1 and 9 being the independent claims.

In the Office Action, claim 2 is objected to, claims 1, 8 and 9 are rejected under 35 U.S.C. §102(e), claims 2, 4-8, 10 and 13-21 are rejected under 35 U.S.C. §103(a), and claims 3 and 22-25 are indicated as containing allowable subject matter.

Applicants respectfully request reconsideration of the present application in view of the following remarks.

The Examiner has objected to claim 2 on the ground that the phrase "the removable memory card" should be replaced with the phrase --a removable memory card--. Applicants respectfully traverse the objection. Claim 2 includes the following recitation, with emphasis supplied:

The camera as claimed in claim 1 wherein both first and second memories are memory locations on the same removable memory card.

Thus, the objected-to phrase "the removable memory card" is not present in the claim. Instead, the claim recites that both the first and second memories are memory locations on "the same removable memory card." The presence of the modifier "same" prior to "removable memory card" overcomes the antecedent basis concerns raised by the Examiner, because it serves as an introduction of the term that follows. Moreover, it is believed that amending the claim to refer to "a same removable memory card" as suggested by the Examiner would actually render the claim grammatically incorrect and unclear. The objection is therefore believed to be improper, and should be withdrawn.

The Examiner has rejected each of claims 2, 4-8, 10 and 13-21 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,737,491 to Allen et al. (hereinafter "Allen") either alone or in combination with another reference. Applicants respectfully traverse the §103(a) rejections on the ground that the Allen reference is not available as a prior art reference for use in a §103(a) rejection against the present application.

Applicants note that the Allen reference utilized by the Examiner in formulating the §103(a) rejections is commonly assigned with the present application. Moreover, the present application, as a divisional application filed on February 14, 2001, is entitled to the benefit of 35 U.S.C. §103(c).

The subject matter of the Allen reference and the claimed invention were, at the time the invention was made, owned by or subject to an obligation of assignment to the same person, namely, Eastman Kodak Company. Therefore, Applicants submit that the Allen reference, which issued April 7, 1998, after the February 20, 1997 priority date of the present application, is not available as prior art in a §103(a) rejection of the present application. See MPEP §706.02(l).

The §103(a) rejections based on Allen are therefore believed to be improper and should be withdrawn.

With regard to the §102(e) rejection of claims 1, 8 and 9 over Allen, Applicants respectfully traverse.

The Manual of Patent Examining Procedure (MPEP), Eight Edition, August 2001, §2131, specifies that a given claim is anticipated "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, MPEP §2131 indicates that the cited reference must show the "identical invention . . . in as complete detail as is contained in the . . . claim," citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the Examiner has failed to establish anticipation of claims 1, 8 and 9 by the Allen reference.

Independent claim 1 is directed to an electronic still camera which includes, among other elements, a first memory for storing images, and a second memory for storing a network configuration file. The network configuration file contains instruction information for communicating with a selected destination via a communications interface. The camera further includes a user interface for selecting an image destination and for commanding the camera to send the image to the selected destination via the communications interface, using the information in the network configuration file.

The Examiner argues that each of the limitations above is shown in Allen. For example, the Examiner argues that the user interface of the claimed camera is met by element 27 of FIG. 1 in Allen. See the Office Action at page 3, middle paragraph. However, in the claimed invention, the user interface is an element of the camera itself. Allen indicates that element 27 is an external input device that connects to a camera 10, and not a user interface that is an element of the camera itself. Accordingly, it is believed that the Examiner has failed to establish anticipation of claim 1 by Allen.

Claim 8 is believed allowable over Allen at least by virtue of its dependence from claim 1.

Independent claim 9, like claim 1, is directed to an electronic still camera having a user interface for performing certain operations. As noted above, such a limitation is not met by the external input device 27 in Allen.

For the reasons identified previously, Allen is not available as a §103(a) reference, and if it does not anticipate each and every element of each of claims 1, 8 and 9, the §102(e) rejection must be withdrawn.

It is believed that the claims in the application are allowable over the prior art and such allowance is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Eastman Kodak Company Deposit Account No. 05-0225.

A duplicate copy of this communication is enclosed.

Respectfully submitted,

A handwritten signature in cursive script, reading "Pamela R. Crocker", written over a horizontal line.

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